



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

OCT 12 2004

BROWDY AND BEIMARK, PLLC
624 NINTH STREET, NW
WASHINGTON, DC 20001

In re Application of :
David Wallach et al :
Serial No.: 09/927,458 : PETITION DECISION
Filed: August 13, 2001 :
Attorney Docket No.: WALLACH-22A :

This is in response to the petition under 37 CFR 1.181, filed October 30, 2003, requesting reversal of an examiner's actions.

BACKGROUND

A review of the file history shows that this is a continuation-in-part of abandoned application SN 09/381,358 and that an identical petition has been filed in that application. That petition will not be addressed directly as this petition decision will render consideration thereof moot.

The '358 application is the National stage entry of PCT/IL98/00125, filed March 19, 1998. The PCT application discloses and claims a specific RAP protein, a deposit of which was made at the Collection Nationale De Cultures Microorganismes (CNCM) at the Institut Pasteur on July 26, 2001 and given Accession No. I-2706. The examiner has rejected the claims of this application over US Pat No. 6,232,081 based on an identical sequence being taught therein and having a priority date earlier than the date of this application or the date of deposit of the sequence. The examiner has also raised the issue that the sequence listing in the parent application and of the deposited sample differ in length and therefore priority cannot be granted back to the date of filing of the PCT application.

The examiner mailed a Final Office action to applicants on June 14, 2004, setting a three month shortened statutory period for reply. The examiner maintained the rejection of the claims based on denial of priority to the PCT application, although such is not explicitly stated therein.

Applicants filed this petition on October 30, 2003, having both the abandoned and current application Serial No.'s thereon. The petition was placed in the abandoned parent file and not further acted on. A copy of the petition will also be entered in this application file.

DISCUSSION

The entire prosecution of this application, and the parent application also, revolves around what the correct sequence for the deposited sample is and the difference in sequence listings in the

applications. Applicants have provided proper affidavits accompanying the identification of the Accession Number for the deposited sample stating that it was in the inventors possession from discovery and filing of the PCT application until deposited in the depository and that availability thereto will not be restricted upon grant of the patent. The only point of dispute is the sequence listing. Applicants attest that the sequence listing filed with the PCT application contained an error. The error was not discovered until after the entry into the National stage occurred in various jurisdictions and preparation for depositing the sequence were being made. At that time the sequence listing in the PCT application could no longer be corrected. However, it could be corrected in National stage applications. The manner of correcting it in the US application was to file a CIP application containing the correct sequence listing with the proper priority claim to the parent and PCT applications. As noted in the petition, the material was identified properly in the earliest application (PCT) even though the correct sequence was not set forth.

Applicants have established by proper affidavit that the material claimed in the original application is the same one claimed herein and has been in the possession of the inventor from time of filing of the earliest application until deposition in a proper depository was made. That an error in determining the correct sequence was made initially does not affect the material, only its identification. Also noted is that the error in the sequence was corrected when it was discovered and prior to its deposition. This is understood to be a not uncommon occurrence as sequencing techniques have improved over time.

In summary, applicants are entitled to a claim of priority for the claimed deposited material and its proper sequence back to the date of the originally filed PCT application. The examiner is directed to accept applicants' affidavits relating to the deposited sequence with respect to this matter as providing proper support therefore.

The petition is **GRANTED**.

Applicants remain under obligation to reply to the Final Office action within the time period set therein or as may be extended under 37 CFR 1.136(a) as no specific request to withdraw the Final rejection appears in the petition. The examiner is instructed to reconsider the rejection of record in view of this decision upon reply by applicants.

As there is no fee for this petition, the petition fee paid of \$130.00 will be credited to applicants' Deposit Account No. 02-4035, as directed.

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number, 703-872-9306.



Jasemine C. Chambers
Director, Technology Center 1600